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AF/3641

501.25507CX5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s):	O. YOKOMIZO, et al
Serial No.:	08/470,424
Filed:	June 6, 1995
For:	FUEL ASSEMBLY AND NUCLEAR REACTOR
Group:	3641
Examiner:	H. Behrend

PETITION UNDER 37 CFR §1.181 AND REPLY TO COMMUNICATIONS DATED DECEMBER 18, 2003 AND JANUARY 22, 2004 AND SUBMISSION OF REVISED APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 23, 2004

Sir:

Appellants, through their undersigned attorney, petition the Director under 37 CFR §1.181 for entry of the Revised Appeal Brief submitted herewith and to require the Examiner to issue an Examiner's Answer in a timely manner, for the reasons set forth below.

Appellants note that an Appeal Brief was initially filed on October 26, 2001 together with a Petition to Withdraw Erroneous Holding of Abandonment. On January 15, 2002, the Petition was granted recognizing that the holding of abandonment was improper in that the U.S. Patent and Trademark Office misplaced the papers filed in this application. That is, the Director stated:

> However, the original amendment, extension of time request and Notice of Appeal submitted by applicant on July 26, 2001 have recently been found, and have been matched with the file. The holding of abandonment is therefore withdrawn and the application is restored to pending status.

> The application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the Amendment, extension of time request, and Notice of Appeal of July 26, 2001, as well as entry of the Appeal Brief of October 26, 2001. The application will then be forwarded to the Primary Examiner for prompt action on the merits of the claims. (emphasis added)

Apparently the Examiner received all of such papers, since the Examiner issued an Advisory Action on January 23, 2002, indicating that none of the claims are allowed.

On June 20, 2003, almost 18 months after issuing of the Advisory Action, the Examiner finally determined that the Appeal Brief filed October 26, 2001 in which the Examiner contended that the Brief was deficient for many reasons, and provided a one month period for reply to submit a new Brief. Petitioners question why the Examiner took almost 18 months from the time the Brief should have been considered to determine that the Brief was non-compliant. Petitioners suggest that the Examiner is concerned about the writing of an Examiner's Answer in response to the Appeal Brief, since as appellants have pointed out in the Appeal Brief, the Examiner has previously lost an Appeal conducted in parent application Serial No. 07/974,834, under Appeal No. 1996-3167 which application has issued as U.S. Patent No. 6,278,757 and which is directed to the structure recited in the method claims on appeal and which structure cannot be ignored. Apparently, the Examiner is concerned about again being reversed on appeal.

On July 21, 2003, appellants submitted a Revised Appeal Brief contending that the submission is considered to be responsive to all the points raised by the Examiner, and in compliance with 37 CFR §1.92(c). According to the records in PAIR, the Appeal Brief was forwarded to the Examiner on July 29, 2003 and more than 4 1/2 months later on December 18, 2003 the Examiner again issued a communication contending that the Appeal Brief is non-compliant. Hereagain, it appears that the Examiner is merely interested in delaying prosecution and has

determined that issuance of a communication contending non-compliance avoids the writing of an Examiner's Answer. Additionally, the communication dated December 18, 2003 apparently required applicant in order to properly respond, according to the Examiner, to obtain an extension of time of five (5) months. The undersigned attorney upon receipt of such communication immediately telephoned the Director and was referred to the SPE, Mr. Corrone, who issued a communication dated January 22, 2004, providing a one month period for reply. Accordingly, submitted herewith is a Revised Appeal Brief which, applicants again contend is in compliance with 37 CFR §1.192(c).

Before discussing the improper position by the Examiner as set forth in the communication dated December 18, 2003, Petitioners submit that it is improper, irrespective of 37 CFR §1.192(d) to permit the Examiner to misinterpret and mischaracterize 37 CFR §1.192(c) and determine compliance or non-compliance therewith based upon the Examiner's misinterpretation to delay or block consideration of the Appeal by the Board by failing to write an Examiner's Answer.

Turning first to page 2 of the communication dated December 18, 2003, in which the Examiner indicates that three of the reasons have still not been corrected in the 7/21/03 brief and the first of these reasons concerns the Summary of the Invention. More particularly, the Examiner states:

> The Summary of the invention as presented in the 7/21/03 brief in attempting to describe appellants invention, still improperly incorporates the subject matter from US 4,285,769 (e.g. see pages 9 and 10 of the brief). Such is improper since this U.S. Patent has not been incorporated by reference into appellants specification.
>
> Appellant can includes this subject matter as part of the Arguments section of the brief or, it could be presented under a separate heading if it is made clear that it is subject matter that may not be supported by the original disclosure but merely provided to enhance the understanding of technical aspects in the art.

Petitioners submit that the reference U.S. Patent No. 4,285,769 is appropriate in the Summary of the Invention in explaining the level of knowledge in the art and accepted terminology in the art, whether or not the Examiner is capable of understanding the terminology, as conventionally utilized in the art since such patent is specifically referred to in the specification. Appellants have not attempted to incorporate U.S. patent by reference into the appellant's specification, although the specification specifically cites such patent as representative of the prior art. Petitioners submit that 37 CFR §1.192(c) requires a concise explanation of the invention defined in claims involved in the appeal, while referring to the specification by page and line number, and to the drawing, if any, by reference characters. The claims on appeal utilize the terminology of "one fuel cycle" and the Examiner has experienced much difficulty with respect to such language. Accordingly, in view of the "red heering" issue raised by the Examiner, appellants have referred to the patent cited at page 16, lines 22 and 23 and page 19, line 29 of the specification of this application, as presenting evidence of the meaning of "one fuel cycle" and the citation properly forms a part of the Summary of the Invention by reference to page and line number in the specification. Thus, the Summary of the Invention retains the reference to U.S. Patent No. 4,285,769, and appellants submit that it is not proper for the Examiner to consider an Appeal Brief to be defective for the reasons set forth by the Examiner. In this regard, the Examiner recognizes that such subject matter could be presented in the Arguments section, and accordingly, this Revised Appeal Brief repeats such information in the Arguments section.

The Examiner again as part of the first reason states:

> The Summary of the Invention must contain a concise explanation of the claimed invention, the Summary of the Invention in the brief however, still improperly refers to non-claimed disclosure (see for example, the brief on page 4 which refers to all of the coolant supplied o the coolant ascending path, as being introduced into the coolant descending path (claims such

> as claim 24 do not even refer to the water rod as having a coolant ascending path and a coolant descending path).

The Examiner contends that the Summary of the Invention refers to non-claimed disclosure, specifically "all" of the coolant with the Examiner indicating that claims such as claim 24 do not even refer to the water rod as having a coolant ascending and a coolant descending path. Appellants note that as recognized by the Examiner, there must be a concise explanation of the claimed invention. Claim 58 which is a dependent claim dependent upon claim 24 provides

> wherein the at least one water rod includes coolant ascending path having a coolant inlet port and coolant descending path connected with the coolant ascending path at a top portion thereof so that all of the coolant supplied into the coolant ascending path is introduced into the coolant descending path in a downward direction opposite to the direction of the flow of the coolant in the coolant ascending path, the coolant descending path having a coolant delivery port. (emphasis added)

It is further noted that dependent claims 59 and 60 dependent upon claims 52 and 54, respectively, recite substantially similar features and represent part of the claimed invention. Thus, contrary to the position set forth by the Examiner, the Summary of the Invention properly refers to the claimed subject matter, and Petitioners submit the Appeal Brief would be non-compliant in failing to provide the same. It is apparent that the Examiner has not even attempted to review the claimed subject matter in contending that the Appeal Brief is non-compliant. Petitioners again submit that this position by the Examiner is evidence of the fact that the Examiner is interested in delay in writing of an Examiner's Answer.

In any event, Petitioners submit that most Examiners, rather than avoiding the writing of an Examiner's Answer in the manner presented by the Examiner herein, would write an Examiner's Answer and point to the alleged deficiencies or mischaracterization of the invention in order to speed the consideration of the Appeal, which has been delayed for more than two years, at this time.

With respect to the second of the three reasons in the paragraph bridging pages 2 and 3 of the communication dated December 18, 2003, that "the Brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief, Petitioners submit that the prior Brief and the present Revised Brief provide arguments in support of such position. By the present revision of the Brief, additional specific arguments have been presented concerning why the claims patentably distinguish from one another in addition to patentably distinguishing over the cited art, such that the claims do not stand or fall together and a heading section with respect thereto has been separately provided. It is noted, however, that 37 CFR §1.192(c)(7) specifically provides a solution to such non-compliance in that in the event that such section has not been complied with, "the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone" (emphasis added). Petitioners again submit that it is not the prerogative of the Examiner to determine whether or not such section has been complied with based upon the Examiner's characterization or interpretation, and the Board can act appropriately. However, the Board can never consider the Appeal if the Examiner continues to dleay or block consideration by failing to write an Examiner's Answer.

As to the third reason, the Examiner states:

> The third of these three reasons is that the brief does not present an argument under a separate heading for each issue on appeal. The 7/21/03 brief still does not comply with this requirement.

Irrespective of the position by the Examiner and possibly the U.S. Patent and Trademark Office in that PTOL-462 representing the communication of June 20, 2003 having the heading "Notification of Non-Compliance with 37 CFR 1.192(c)" in item 7, provides "The brief does not present an argument under a separate heading

for each issue on appeal. 37 CFR 1.192(c)(8)" (emphasis added), Petitioners note that the language of 37 CFR §1.192(c)(8) is that:

Each issue should be treated under a separate heading.

Petitioners submit that interpretation of "should" differs from "must" (see 37 CFR §1.192(a)) or "shall" (see 37 CFR 1.192(c)) which are words considered to be "mandatory", whereas "should" is interpreted as discretionary or recommended, but not mandatory. Thus, Petitioners submit that the Examiner's position with regard to the third reason is also erroneous.

In any event, irrespective of whether or not the Examiner considers the headings as utilized in the Brief to exactly correspond with the issues as identified, Petitioners submit that the Brief does, in fact, treat each issue under a separate heading, and hereagain, the third reason presented by the Examiner is improper.

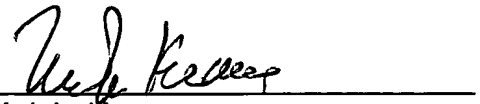
For the foregoing reasons, Petitioners submit that the reasons presented by the Examiner for non-compliance with 37 CFR §1.192 of the various Briefs filed are erroneous and based upon the Examiner's misinterpretation of 37 CFR §1.192 and misreading of the arguments presented. Petitioners submit that the Examiner should not be empowered to delay and substantially prevent consideration of an Appeal by the Board by denying entry of an Appeal Brief, based solely upon the Examiner's mischaracterization and misinterpretation and apparent desire to avoid writing an Examiner's Answer. In any event, Petitioners submit that the Appeal Brief submitted herewith is in full compliance with 37 CFR §1.192(c), and Petitioners request the Director to require entry of the Appeal Brief submitted herewith and require the Examiner to finally write an Examiner's Answer in this application on appeal.

Accordingly, granting of this Petition is respectfully requested.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing

of this paper, including extension of time fees, to Deposit Account No. 01-2135 (501.25507CX5) and please credit any excess fees to such deposit account.

Respectfully submitted,



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